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PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63916

Toshio YAGIHASHI, et al.

Appln. No.: 09/825,333

Group Art Unit: 3621

Confirmation No.: 1819

Examiner: BACKER, Firmin

Filed: April 4, 2001

For: MAIL-ORDER SYSTEM USING NETWORK AND MAIL-ORDERING METHOD
THEREOF

SUBMISSION OF APPEAL BRIEF

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Submitted herewith please find an Appeal Brief. A check for the statutory fee of \$340.00 is attached. The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account. A duplicate copy of this paper is attached.

Respectfully submitted,

Ronald Kimble
Registration No. 44,186

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: November 2, 2004



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APPEAL BRIEF UNDER 37 C.F.R. § 41.37

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P.O. Box 1450

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Sir:

In accordance with the provisions of 37 C.F.R. § 41.37, Appellant submits the following:

I. REAL PARTY IN INTEREST

The real party in interest is NEC CORPORATION by virtue of an assignment executed by TOSHIO YAGIHASHI and SHOUJI NARISAWA (hereinafter "Appellants") on March 26, 2001 and recorded in the U.S. Patent and Trademark Office on April 4, 2001 at Reel 011678, Frame 0238.

II. RELATED APPEALS AND INTERFERENCES

Upon information and belief, there are no other prior or pending appeals, interferences, or judicial proceedings known to Appellant, Appellant's representatives or the Assignee that may be related to, be directly affected by, or have a bearing on the Board's decision in this appeal.

III. STATUS OF CLAIMS

Claims 1-27 are pending and are the basis of this appeal (*see* Claims Appendix). Claims 1-27 stand rejected.

IV. STATUS OF AMENDMENTS

No amendments have been submitted after the final rejection of the claims in the May 21, 2004 Office Action.

V. SUMMARY OF THE CLAIMED SUBJECT MATTER

The present invention is a mail-order system. Claims 1, 6, 11, 16, 20, and 24 are the independent claims and their features are described herein.

One embodiment of the invention is shown in FIG. 1. The invention may include a user (member) side terminal 100 and a server 105 for members for conducting management and authentication of member information, both of which are connected to an Internet network 111 through a communication interface unit 110 (Appellant's specification: page 17, line 23 - page 18, line 1; and Fig. 1).

A mail-order site side sever 112 or 113 is also connected to the Internet network 111. The communication interface unit 110 and the Internet network 111 may constitute a public line network (Appellant's specification: page 18, lines 2-4; and Fig. 1).

Claims 1, 6, and 11, *inter alia*, recite a registration unit for registering physical characteristics of each member in advance, and a processing unit responsive to the application of the physical characteristic information. These features are described in the specification as follows (note that independent claims 16, 20, and 24 recite the corresponding method of these structural elements). Connected to the user side terminal 100 are a keyboard 101 for inputting personal authentication information of a member, a scanner 102 for inputting physical characteristics and the like of a member, an Internet connection software 103 and a display unit 104 (Appellant's specification: page 18, lines 5-9; and Fig. 1).

Connected to the server for members 105 are a temporary file 106 for storing member's personal authentication information, an information registration unit 107 for registering

member's physical characteristics, an encipherment and decoding unit 108 for enciphering physical characteristic information and personal authentication information so as to be correlated with each other or decoding personal authentication information from applied physical characteristics and a processing unit 109 responsive to application of physical characteristics for comparing the applied characteristics and registered information of the information registration unit 107 to conduct authentication and responsive to authentication results for allowing or not allowing connection to the mail-order site side server 112 or 113 through the communication interface unit 110 (Appellant's specification: page 18, lines 10-26; and Fig. 1).

In operation, a user (member) inputs personal authentication information for authenticating a member as member identification information (ID) and a password (PW) through the keyboard 101. The input personal authentication information is stored in a personal authentication information table 601 (Appellant's specification: page 19, lines 5-9; and Figs. 1 and 6).

Next, the member inputs his or her own physical characteristics (for example, a finger print or palm print) through the scanner 102. Then, the input physical characteristic information PF is registered at the information registration unit 107 of the server for members 105. Thereafter, the physical characteristic information PF and member's personal authentication information are enciphered in correlation with each other by the encipherment and decoding unit 108. Lastly, the enciphered data is stored at the information registration unit 107 as such an encipherment table 602 (Appellant's specification: page 19, lines 15-26; and Figs. 1 and 6). Thus, secure and efficient ordering can be performed over a network.

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There are no recited mean plus function limitations.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hiratsuka et al. (U.S. Patent No. 6,526,396) in view of Yamada (U.S. Patent No. 6,373,100).

VII. ARGUMENTS

Claims 1-27 are patentable Hiratsuka et al. in view of Yamada

As noted above, claims 1-27 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Hiratsuka et al. in view of Yamada. It is respectfully submitted that claims 1-27 are patentable over Hiratsuka et al. in view of Yamada for at least the following reasons

A. Claims 1, 6, 11, 16, 20, and 24

The Examiner alleges that, as per claims 1, 6, 11, 16, 20 and 24 (the independent claims) that Hiratsuka et al. teach using personal authentication information for authenticating a member as member identification information and a password. The Examiner further states that this process is performed by a registration unit for registering physical characteristics of each member in advance; and a processing unit responsive to application of physical characteristics by a purchaser for comparing the applied physical characteristic information and the physical characteristic information registered at the registration unit to conduct authentication, and determining whether connection is allowed or not according to authentication results (citing the Abstract, and portions of column 3).

The Examiner correctly acknowledges that Hiratsuka et al. fail to teach a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network. Nonetheless, the Examiner states that Yamada teaches a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network (citing Figures 1-3, and column 1, lines 19-45). Thus, the

Examiner alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Hiratsuka et al's inventive concept to include the Yamada concept of a mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network because this would have provided a system for shopping wherein a customer can order merchandise and designate addresses or places where the good or merchandise can be delivered. Applicants respectfully traverse this rejection.

Specifically, Applicants submit that the Examiner has not presented persuasive arguments necessary for a *prima facie* case of obviousness. Applicants note that most if not all inventions arise from a combination of old elements. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Thus, every element of a claimed invention may often be found in the prior art. *Id.* However, identification in the prior art of each individual part claimed is insufficient to defeat patentability of the whole claimed invention. *Id.* Rather, to establish obviousness based on a combination of the elements disclosed in the prior art, there must be some motivation, suggestion or teaching of the desirability of making the specific combination that was made by the applicant. *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1316 (Fed. Cir. 2000) (citing *In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998); *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)).

The purpose of the Yamada on-line shopping system is to be able to order a product, and then have the product delivered to a 24-hour convenience store 9 rather than the customer's

home so that a delivery is not missed (see Abstract). After ordering, the customer 3 can confirm via terminal equipment 3a that the product has been delivered to the convenience store 9. At the convenience store 9, the shop assistant verifies the customer identification information using an ID card against the information on the delivered package, and then releases the package to the customer (see col. 3, line 55 through col. 4, line 3). As such, the customer can get the package at any time from the convenience store, and the home deliverer never has to redeliver a package due to the customer not being home. Accordingly, the method disclosed by Yamada is based on a traditional package delivery service. There is *no suggestion* that actual physical characteristics be registered or processed, such as a finger print to provide identification of a customer as recited in the independent claims of the present application (as recited in the aforementioned independent claims).

Applicants note that “defining the problem in terms of its solution reveals improper hindsight in the selection of the prior art relevant to obviousness.” *Exolochem, Inc. v. Southern California Edison Co.*, 227 F.3d 1361, 1363, 56 USPQ2d 1065, 1067 (Fed. Cir. 2000)
“Therefore, when determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the desirability, and thus obviousness, of making the combination.” *Id.*

Applicants submit, based on the Examiner's reasons for combining the references, that the Examiner has improperly rejected the claims for at least three reasons. First, analogous to *Exolochem*, the Examiner has defined the problem in terms of the solution, revealing improper hindsight in the selection of the prior art relevant to obviousness. As stated above, there is no teaching or suggestion in the patents themselves of making this specific combination, specifically as the problem that Yamada solves is how to deliver a package so that a customer does not have to be at the delivery location when it is delivered. The present invention solves a different problem - that of controlling access to a mail-order site. The present invention solves this problem by using physical characteristics of a person as well as a password.

Second, and equally important, the Examiner states that the reason for combining the references is to provide a system for shopping wherein the customer can order merchandise and designate addresses or places where the goods or merchandise can be delivered. Applicants fail to see how designating a place to deliver goods or merchandise, as taught by Yamada, would motivate one of ordinary skill in the art to incorporate its on-line shopping method into a personal identification apparatus (Hiratsuka et al.) as the Examiner concludes. Delivery of goods is quite different than controlling access to a mail-order site.

Finally, case law provides that the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991) (see also MPEP 2143). For the reasons discussed above, the rejection is "hindsight reconstruction" since the *only* basis for achieving the claimed invention from the combination of

Yamada and Hiratsuka et al., as proposed by the Examiner, would be impermissible hindsight reliance upon Applicants' own teaching in the present application.

B. Claims 2-5, 7-10, 12-15, 17-19, 21-23, 25, and 27.

These claims are allowable at least based on their dependence on the aforementioned independent claims.

The Examiner's Reasoning in the May 21, 2004 Office Action Response to Arguments Does Not Support a *Prima Case* of Obviousness and Again Shows Hindsight

In the May 21, 2004 Response to Arguments, the Examiner cites features of Hiratsuka et al. and Yamada, and then summarily concludes on page 6 of the Office Action that because "these two inventive concepts are in the same environment which make them combinable in order to produce the same result as the Applicant's claimed inventive concept. " Applicants respectfully submit this view by the Examiner does not provide the motivation, suggestion or teaching of the desirability of making the specific combination. Further, as suggested by the statements, the Examiner is defining the problem in terms of its solution, which reveals improper hindsight in the selection of the prior art relevant to obviousness.

Unless a check is submitted herewith for the fee required under 37 C.F.R. §41.37 and 1.17(c), please charge said fee to Deposit Account No. 19-4880.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Ronald Kimble
Registration No. 44,186

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: November 2, 2004

CLAIMS APPENDIX

CLAIMS 1-27 ON APPEAL:

1. A mail-order system for members by which a member purchases commodities by accessing a mail-order site side server through a network using such personal authentication information for authenticating a member as member identification information and a password, comprising:

registration unit for registering physical characteristics of each said member in advance;
and

processing unit responsive to application of physical characteristics by a purchaser for comparing the applied physical characteristic information and the physical characteristic information registered at said registration unit to conduct authentication and determining whether connection to said mail-order site side server through said network is allowed or not according to authentication results.

2. The mail-order system as set forth in claim 1, further comprising
a server for members for authenticating said member, wherein
said registration unit and said processing unit are provided at said server for members.

3. The mail-order system as set forth in claim 1, further comprising
unit for enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and

reading and decoding said information enciphered.

4. The mail-order system as set forth in claim 1, further comprising

unit for enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said decoding unit decodes said personal authentication information when results of authentication of a purchaser's physical characteristics applied at the purchase of a commodity and said registered physical characteristics coincide with each other.

5. The mail-order system as set forth in claim 1, further comprising

unit for enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said decoding unit decodes said personal authentication information when results of authentication of a purchaser's physical characteristics applied at the purchase of a commodity and said registered physical characteristics coincide with each other, and

said processing unit transmits said personal authentication information decoded to said mail-order site side server.

6. A mail-order system for members by which a member makes a settlement for mail-ordering by accessing a mail-order settlement server through a network using such authentication information for authenticating a card of a member who makes a settlement for mail-ordering as identification information and a password, comprising:

registration unit for registering physical characteristics of each said member in advance;
and

processing unit responsive to application of physical characteristics of one who makes a settlement and to application of physical characteristics by a purchaser for comparing the applied physical characteristic information and the physical characteristic information registered at said registration unit to conduct authentication and determining whether connection to said mail-order settlement server through said network is allowed or not according to authentication results.

7. The mail-order system as set forth in claim 6, further comprising
a server for members for authenticating said member, wherein
said registration unit and said processing unit are provided at said server for members.

8. The mail-order system as set forth in claim 6, further comprising
unit for enciphering said personal authentication information and said physical
characteristic information so as to be in correlation with each other and registering the
enciphered information at said registration unit, and reading and decoding said information
enciphered.

9. The mail-order system as set forth in claim 6, further comprising
unit for enciphering said personal authentication information and said physical
characteristic information so as to be in correlation with each other and registering the
enciphered information at said registration unit, and reading and decoding said information
enciphered, wherein

said decoding unit decodes said personal authentication information when results of
authentication of physical characteristics of one who makes a settlement applied at the settlement
of mail-ordering and said registered physical characteristics coincide with each other.

10. The mail-order system as set forth in claim 6, further comprising
unit for enciphering said personal authentication information and said physical
characteristic information so as to be in correlation with each other and registering the
enciphered information at said registration unit, and reading and decoding said information
enciphered, wherein

said decoding unit decodes said personal authentication information when results of
authentication of physical characteristics of one who makes a settlement applied at the settlement
of mail-ordering and said registered physical characteristics coincide with each other, and

said processing unit transmits said personal authentication information decoded to said
mail-order settlement server.

11. An Internet connection system enabling connection to at least one of contracted providers by member's access to the Internet through a network using such personal authentication information for authenticating a member as member identification information and a password, comprising:

registration unit for registering physical characteristics of each said member in advance, and processing unit responsive to application of physical characteristics by one who makes a connection for comparing the applied physical characteristic information and the physical characteristic information registered at said registration unit to conduct authentication and determining whether connection to said provider through said network is allowed or not according to authentication results.

12. The Internet connection system as set forth in claim 11, further comprising a server for members for authenticating said member, wherein said registration unit and said processing unit are provided at said server for members.

13. The Internet connection system as set forth in claim 11, further comprising unit for enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered.

14. The Internet connection system as set forth in claim 11, further comprising unit for enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said decoding unit decodes said personal authentication information when results of authentication of physical characteristics of one who makes a connection applied at the connection and said registered physical characteristics coincide with each other.

15. The Internet connection system as set forth in claim 11, further comprising unit for enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said decoding unit decodes said personal authentication information when results of authentication of physical characteristics of one who makes a connection applied at the connection and said registered physical characteristics coincide with each other, and

said processing unit transmits said personal authentication information decoded to said provider.

16. A mail-ordering method for members by which a member purchases commodities by accessing a mail-order site side server through a network using such personal authentication information for authenticating a member as member identification information and a password, comprising the steps of:

registering physical characteristics of each said member in advance; and
in response to application of physical characteristics by a purchaser, comparing the applied physical characteristic information and the physical characteristic information registered at said registration unit to conduct authentication and determining whether connection to said mail-order site side server through said network is allowed or not according to authentication results.

17. The mail-ordering method as set forth in claim 16, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered.

18. The mail-ordering method as set forth in claim 16, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said personal authentication information is decoded when results of authentication of a purchaser's physical characteristics applied at the purchase of a commodity and said registered physical characteristics coincide with each other.

19. The mail-ordering method as set forth in claim 16, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said personal authentication information is decoded when results of authentication of a purchaser's physical characteristics applied at the purchase of a commodity and said registered physical characteristics coincide with each other, and

said personal authentication information decoded is transmitted to said mail-order site side server.

20. A mail-ordering method for members by which a member makes a settlement for mail-ordering by accessing a mail-order settlement server through a network using such authentication information for authenticating a card of a member who makes a settlement for mail-ordering as identification information and a password, comprising the steps of:

registering physical characteristics of each said member in advance; and

in response to application of physical characteristics of one who makes a settlement and to application of physical characteristics by a purchaser for comparing the applied physical characteristic information and the physical characteristic information registered at said

registration unit to conduct authentication and determining whether connection to said mail-order settlement server through said network is allowed or not according to authentication results.

21. The mail-ordering method as set forth in claim 20, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered.

22. The mail-ordering method as set forth in claim 20, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein said personal authentication information is decoded when results of authentication of physical characteristics of one who makes a settlement applied at the settlement of mail-ordering and said registered physical characteristics coincide with each other.

23. The mail-ordering method as set forth in claim 20, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein

said personal authentication information is decoded when results of authentication of physical characteristics of one who makes a settlement applied at the settlement of mail-ordering and said registered physical characteristics coincide with each other, and

said personal authentication information decoded is transmitted to said mail-order settlement server.

24. An Internet connection method enabling connection to at least one of contracted providers by member's access to the Internet through a network using such personal authentication information for authenticating a member as member identification information and a password, comprising the steps of:

registering physical characteristics of each said member in advance; and
in response to application of physical characteristics by one who makes a connection, comparing the applied physical characteristic information and the physical characteristic information registered at said registration unit to conduct authentication and determining whether connection to said provider through said network is allowed or not according to authentication results.

25. The Internet connection method as set forth in claim 24, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered.

26. The Internet connection method as set forth in claim 24, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein said personal authentication information is decoded when results of authentication of physical characteristics of one who makes a connection applied at the connection and said registered physical characteristics coincide with each other.

27. The Internet connection method as set forth in claim 24, further comprising the step of enciphering said personal authentication information and said physical characteristic information so as to be in correlation with each other and registering the enciphered information at said registration unit, and reading and decoding said information enciphered, wherein said personal authentication information is decoded when results of authentication of physical characteristics of one who makes a connection applied at the connection and said registered physical characteristics coincide with each other, and

said personal authentication information decoded is transmitted to said provider.

EVIDENCE APPENDIX

NONE.

RELATED PROCEEDINGS APPENDIX

NONE.